

Claims 53, 68-74, and 101 have been canceled and claims 54-57, 59, 60, 62, 95, 102-105, 107 and 108-114 have been amended. Applicants expressly assert that these claims were canceled and amended for the sole purpose of facilitating prosecution, and not in an effort to overcome the 35 U.S.C. §§102 and 103 rejections based on cited prior art, or in an effort to overcome rejections based on 35 U.S.C. § 112.

The Examiner objected to claims 54, 62, 69, 95, and 102 alleging the claims were in improper dependent form for failing to further limit the subject matter of a previous claim. As kindly suggested by the Examiner, Applicants have amended claims 54, 62, 95, and 102, to independent form and cancelled claim 69. Applicants respectfully request that the objection of claims 54, 62, 95, and 102 be withdrawn.

The title has also been amended to more clearly describe the claimed invention.

### **Rejections Under 35 U.S.C. § 101**

#### *Statutory Double Patenting*

Claims 53, 60 and 75 were rejected under 35 U.S.C § 101 as claiming the same invention as that of claims 9, 14, and 20, respectively of prior U.S. Patent No. 5,747,280.

Applicants have cancelled claim 53, thereby rendering the rejection moot as to this claim. However, Applicants respectively traverse the rejection of claims 60 and 75 because they are not directed to the same invention as that of claims 14 and 20 of the '280 patent. Claim 60 of the instant application as amended is directed to "[a]n isolated polynucleotide comprising a nucleic acid sequence encoding amino acids -20 to +163 of SEQ ID NO:2", whereas claim 14 of the '280 patent is directed to "[t]he isolated polynucleotide of claim 1 comprising a polynucleotide encoding a polypeptide comprising the amino sequence identical to amino acids -21 to 163 of SEQ ID NO:2." (Emphasis added.) Thus, the two claims are drawn to unique subject matter.

Moreover, Claim 75 of the instant application is directed to "[a]n isolated polynucleotide comprising a nucleic acid sequence encoding the mature portion of the protein encoded by the cDNA clone of ATCC Deposit No. 75874", whereas claim 20 of the '280 patent is directed to "[t]he isolated polynucleotide of claim 19, wherein said polynucleotide comprises DNA identical to the coding portion of the human cDNA in ATCC Deposit No. 75874 which encodes a mature polypeptide". Claim 20 of the '280 patent is dependent from claim 19, which is a method claim. Therefore, claim 75 of the present application and claim

20 of the '280 patent are not drawn to identical subject matter. Applicants respectfully request that the double patenting rejection of claims 53, 60 and 75 be withdrawn.

*Non-statutory Double Patenting*

Claims 54-59, 61-67, and 76-80 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-10, 14-15, and 20-21, respectively of U.S. Patent 5,747,280. Moreover, claims 81-92 are rejected under the doctrine of double patenting over claims 20-21 of the '280 patent, and claims 93-114 are rejected under the doctrine of double patenting over claims 1-22 of the '280 patent. Applicants file herein a Terminal Disclaimer in full compliance with 37 CFR 1.321(c). Applicants respectfully request that the non-statutory double patenting rejection of claims 54-59, 61-67, 76-80, 81-92, and 93-114 be withdrawn.

*Provisional Non-statutory Double Patenting*

The Examiner provisionally rejected claims 93-100, 108 and 111-112 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 08/196,362 (SEQ ID NO: 7788 and 7775), 08/346,731 (SEQ ID NO: 552), 08/420,856 (SEQ ID NO: 552), 08/221,623 (SEQ ID NO: 114), and 08/276,163 (SEQ ID NO: 15161). Applicants request that any provisional obviousness-type double patenting rejection be held in abeyance until indication of allowable subject matter. Additionally, Applicants take this opportunity to advise the Examiner that, upon indication of allowable subject matter in the instant application, Applicants will cancel all text in the above listed co-pending specifications relating to the above listed species, cancel all sequence listings relating to the above listed species, and will withdraw the deposits of the above listed species.

**Rejections Under 35 U.S.C. § 112**

The Examiner rejected claims 68-92, 101-108 and 111-112 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification. (Paper No. 8, page 7, section 12.) The Examiner kindly suggested that this requirement of 35 U.S.C. § 112 may be satisfied by a deposit of the plasmid.

To demonstrate full compliance with 37 C.F.R. §§ 1.803-1.809 and to satisfy the requirement of 35 U.S.C. § 112, first paragraph, Applicants assure the Examiner that ATCC

Deposit No. 75874 has been deposited under the terms of the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure with the following International Depository Authority: American Type Culture Collection (ATCC), 10801 University Blvd., Manassas, Virginia 20110-2209, USA. The deposit comprises a recombinant nucleic acid vector into which cDNA sequences encoding Human Vascular IBP-Like Growth Factor (VIGF) has been inserted. The deposit was made on August 24, 1994, as disclosed on page 5, fourth full paragraph of the instant application.

In accordance with MPEP § 2410.01 and 37 C.F.R. § 1.808, assurance is hereby given that all restrictions on the availability to the public of the above nucleic acid molecules encoding human VIGF, will be irrevocably removed upon the grant of a patent based on the captioned application, and that the deposit will be replaced if viable samples cannot be dispensed by the ATCC, except as permitted under 37 C.F.R. § 1.808(b). Applicants respectfully request the rejection as it would apply to pending claims 75-92, 102-108, and 111-112 be withdrawn.

The Examiner rejected claim 108(d) because the use of the word nucleic acid "sequence" is allegedly confusing. Although applicants respectfully disagree, in the interest of facilitating prosecution, applicants have amended claims 108-114 removing the word "sequence". Applicants respectfully request the rejection of 108(d) be withdrawn.

### **Rejections Under 35 U.S.C. § 102**

The Examiner provisionally rejected claims 93-100, 108, and 111-112 under 35 U.S.C. § 102 (e) as being anticipated by copending Application No. 08/196,362 (SEQ ID NO: 7788 and 7775), 08/346,731 (SEQ ID NO: 552), 08/420,856 (SEQ ID NO: 552), 08/221,623 (SEQ ID NO: 114), and 08/276,163 (SEQ ID NO: 15161). Applicants request that the provisional 102(e) rejection be held in abeyance until indication of allowable subject matter. Additionally, Applicants take this opportunity to advise the Examiner that, upon indication of allowable subject matter in the instant application, Applicants will cancel all text in the above listed co-pending specifications relating to the above listed species, cancel all sequence listings relating to the above listed species, and will withdraw the deposits of the above listed species.

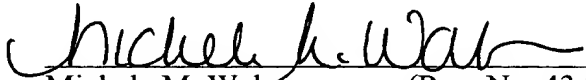
### **Conclusion**

In view of the foregoing remarks, Applicants believe they have fully addressed the Examiner's concerns and that this application is now in condition for allowance. An early notice to that effect is urged. A request is made to the Examiner to call the undersigned at the phone number provided below if any further action by Applicants would expedite allowance of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: 9/14/99

  
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Enclosure  
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